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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,641	12/29/2000	Charles A. Milligan	00-117-DSK	9245

7590

05/18/2004

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EXAMINER

LANE, JOHN A

ART UNIT	PAPER NUMBER
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2188

DATE MAILED: 05/18/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/751,641

Applicant(s)

MILLIGAN ET AL.

Examiner

Jack A Lane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2000.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-30 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-30 are presented for examination. The serial nos. of the cross reference to provisional and related applications on page 1 is requested in response to this Office action. The attorney docket no.'s must be deleted from page 1.

2. The examiner requests, in response to this Office action, any reference(s) known to qualify as prior art under 35 U.S.C. sections 102 or 103 with respect to the instant claims. That is, any prior art (including any products for sale) similar to the instant claimed invention that could reasonably be used in a 102/103 rejection. This request does not require applicant to perform a search. This request is not intended to interfere with or go beyond that required under 37 C.F.R. 1.56 or 1.105. This request may be fulfilled by asking the attorney(s) of record handling prosecution and the inventor(s)/assignee for references qualifying as prior art. A simple statement that the query has been made and no prior art found is sufficient to fulfill the request. Otherwise, the fee and certification requirements of 37 CFR section 1.97 are waived for those documents submitted in reply to this request. This waiver extends only to those documents within the scope of this request under 37 CFR, section 1.105 that are included in the application's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this request and any information disclosures beyond the scope of this request under 37 CFR section

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1.105 are subject to the fee and certification requirements of 37 CFR section 1.97. In the event prior art documentation is submitted a discussion of relevant passages, figs. etc. is requested. **A response to this inquiry is greatly appreciated.**

The examiner also requests, in response to this Office action, support be shown for language added to the claims on amendment. That is, indicate support for newly added claim language by specifically pointing to page(s) and line no(s). in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. Claims 1 and 22 are rejected under 35 U.S.C. § 102(e) as being anticipated by Voigt et al. (Pat. No. 5,960,451).

Voigt teaches the claimed "data elements" as corresponding to the logical storage units (LUNs) (see the Summary). The claimed "metadata" corresponds data including

management information such as that found in RAID management system 56. RAID management system 56 maps physical storage space to RAID-level virtual storage space. The claimed "metadata" also including data including management management rules and processing rules such as Voight's parameters/preferences such as physical capacity, number of storage disks, allocated capacity, characteristics of the RAID, percentage to be used (col. 2, line 55 – col. 3, line 2) performance (col. 4, line 16) and availability (col. 7, lines 26-42). The claimed "one or more anchor points" corresponds to places (addresses) within computer system 20 holding programs for computing available capacity (claimed analysis processes) (see col. 5, line 66 – col. 6, line 39).

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103 (a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

7. Claims 2-21 and 23-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Voigt et al. (5,960,451).

Voigt teaches the invention substantially as claimed as discussed above in section 5. The examiner believes most, if-not-all, dependent claim features are taught by Voigt. However, in the event a claim feature(s) is not inherent applicant should consider the claim feature(s) in light of the Official notification put forth below. For example, claim 2 recites a “management information comprises a time stamp” and claim 5 recites a “pointer to a management rule.” A time stamp is generally used to identify the age of data or the last time something was changed. A pointer or address is well known to indicate the location of that which is sought after. For instance the maps discussed in Voigt are essentially addresses or pointers to physical/virtual locations.

Official notice is taken of the prior art teaching any claim feature not specifically discussed above. That is, any prior art (including that of record) teaching the more well known claim features commonly found in the dependent claims. The claim feature(s), while part of the invention, appears to be well known and it's relevance not essential to the main invention found in the independent claim(s). Thus, a detailed discussion of the well known claim feature(s) is not warranted at this time. Because time stamps are well known for maintaining information on the age of data or the last time a change was made,

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it would have been obvious to use time stamps with the performance parameters of Voigt to monitor and make changes as the system ages. Therefore, the claimed invention would have been obvious to one of ordinary skill in the art at the time of the invention.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should review the prior art not relied upon for its relevance to the instant claims.

Blumenau et al. (6,282,602), Milligan et al. (6,546,458) and Carter et al. (6,026,474) discuss metadata.

Any response to this action should be mailed to:

Under Secretary of Commerce for Intellectual Property and Director
of the United States Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306, (for Official communications intended for entry)

Or:

(703) 872-9306, (for Non-Official or draft communications, please
label "Non-Official" or "DRAFT")

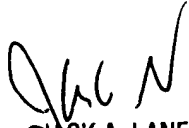
Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack A. Lane whose telephone number is 703 305-3818. The examiner can normally be reached on Mon-Fri from 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mano Padmanabhan can be reached on 703 306-2903.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-3900.


JACK A. LANE
PRIMARY EXAMINER